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PATENT
Docket No. 53481US009 (formerly 53481USA1B)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#13/m

01-10-03

Applicant(s): Wayne K. DUNSHEE et al.)
Serial No.: 09/577,551)
Confirmation No.: 5353)
Filed: 24 May 2000)
For: ABRASION-RESISTANT INK COMPOSITIONS AND METHODS OF USE)

Group Art Unit: 1714
Examiner: Patrick Dennis Niland

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APPELLANTS' BRIEF ON APPEAL

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This Brief is presented in support of the Appeal filed October 22, 2002, from the final rejection of claims 11-13, 16-45, and 49-52 of the above-identified application under 35 U.S.C. § 102 (claims 11, 13, 16-21, 23, 24, 25-27, 30-33, and 39-43) and 35 U.S.C. § 103 (claims 11-13, 16-45, and 49-52), as set forth in the Final Office Action mailed May 24, 2002.

This Brief is being submitted in triplicate, as set forth in 37 C.F.R. § 1.192(a). The Examiner is authorized to charge Deposit Account No. 13-4895 in the amount of \$320.00 to cover the fee for filing this Brief under 37 C.F.R. § 1.17(f).

I. REAL PARTY IN INTEREST

The real party in interest of the above-identified patent application is the assignee,
3M Innovative Properties Company.

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants' Representatives that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

The claims in the present application are claims 11-13, 16-45, and 49-52. The amendments made in the Amendment and Response filed August 26, 2002 (a copy of which is enclosed as Appendix V), will be entered herewith as indicated by the Examiner's Advisory Action (Appendix VI). Therefore, Claims 11-13, 16-33, 35-37, 39-45, and 49-52 (Appendix I), reflect the pending claims from the Amendment and Response filed August 26, 2002 (Appendix V), which are the subject of this Appeal.

IV. STATUS OF AMENDMENTS

The present Application, filed May 24, 2000, is a divisional application of Serial No. 08/949,903, filed October 15, 1997, abandoned.

A nonfinal Office Action (a copy of which is enclosed as Appendix II) was mailed on December 3, 2001, in which claims 11, 13, 15-21, 23, 24, 25-27, 30-33, and 39-43 were

rejected under 35 U.S.C. § 102(b), and claims 11-45 and 49-52 were rejected under 35 U.S.C. § 103(a).

Appellants filed an Amendment and Response, dated March 4, 2002 (Appendix III), in which claims 11, 12, 16, 17, 22, 34, 37, 39, and 43 were amended and claims 14 and 15 were cancelled. The amended independent claims (claims 11, 16, and 39), and claims 17, 34, 37, and 43 dependent therefrom, were amended to recite an elastomeric substrate or an elastomeric bandage. Claim 11 was further amended to recite coating an imagewise layer of a urethane polymer-containing ink composition, and claim 12, dependent therefrom, was amended to recite a urethane polymer-containing ink composition that is a water-based composition. Claim 39 was further amended to recite a method comprising applying at least one ink composition in an imagewise fashion. Claim 22 was amended simply to correct a grammatical error.

A final Office Action (Appendix IV) was mailed on May 24, 2002, in which the 35 U.S.C. §§ 102 and 103 rejections were maintained as described in the nonfinal Office Action mailed on December 3, 2001.

Appellants filed an Amendment and Response under 37 C.F.R. § 1.116, dated August 26, 2002 (Appendix V), in which claims 11, 16, 25, 35, 37, and 39 were amended and claims 34 and 38 were cancelled. Independent claims 11, 16, and 25 were amended to recite an elastomeric bandage, and claims 11, 16, 25, and 39 were amended to recite that the image, the ink composition, and/or ink layer is printed, coated, and/or applied to an elastomeric substrate

which forms a part of the elastomeric bandage. Dependent claims 35 and 37 were amended simply to depend from a non-cancelled claim.

An Advisory Action (Appendix VI) was mailed September 17, 2002, in which (1) Appellants' response to the final rejection was deemed not to place the application in condition for allowance, (2) upon the filing of an Appeal the proposed amendment would be entered, and (3) Appellants' response overcame the rejection of claims 11, 13, 16-21, 23, 24, 25-27, 30-33, and 39-43 under 35 U.S.C. § 102(b) (the rejection made in paragraph 4 of the final Office Action mailed May 24, 2002).

All amendments were entered.

V. SUMMARY OF THE INVENTION

Appellants' invention is directed to an ink and/or an image on an elastomeric bandage, and methods thereof. More specifically, the invention is directed to an elastomeric bandage comprising a printed image (claim 49), a method for printing an image on an elastomeric bandage (claims 16 and 25), a method for improving durability of an image on an elastomeric bandage (claim 11), and a method for limiting abrasion of an ink on an elastomeric bandage (claim 39). Various embodiments of the elastomeric bandage and methods are claimed.

VI. ISSUE PRESENTED FOR REVIEW

Whether claims 11-13, 16-33, 35-37, 39-45, and 49-52 are obvious under 35 U.S.C. § 103 over U.S. Patent No. 5,162,141 (Davey et al.) in view of U.S. Patent No. 4,334,530 (Hassell) and EP 596503 (Miyamoto et al.) (These documents are provided herein as Appendix VII).

VII. GROUPING OF CLAIMS

For the purpose of this appeal, claims 11-13, 16-33, 35-37, 39-45, and 49-52 stand or fall together.

VIII. ARGUMENT

A. Claims 11-13, 16-33, 35-37, 39-45, and 49-52 are not obvious under 35 U.S.C.

§ 103 over Davey et al. in view of Hassell and Miyamoto et al.

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined." M.P.E.P. § 2141 (citations omitted).

1. Davey et al. and Miyamoto et al. may not be relied upon as prior art for

the purpose of an obviousness rejection as they are drawn to nonanalogous art.

To rely on a reference under 35 U.S.C. § 103, it must be analogous prior art (M.P.E.P. § 2141.01(a)). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned," In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Furthermore, in determining what is analogous prior art, "the similarities and differences in structure and functions of the inventions [to] carry far greater weight." In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

Appellants submit that neither the polymeric sheets of Davey et al. nor the polyurethane resins useful for food packaging of Miyamoto et al. are either in the field of Appellants' elastomeric bandages nor do they disclose an article that has any similarity and/or function whatsoever to the elastomeric bandages of Appellants' invention. Furthermore, neither the teachings of Davey et al. nor of Miyamoto et al. are reasonably pertinent to the problems encountered in applying ink compositions and images to the elastomeric bandages of Appellants' invention.

Davey et al. disclose a polymeric sheet having an incompatible ink permanently bonded thereto (Davey et al., column 2, lines 35-37) for use as decorative surface products for floors, walls, and furniture (Davey et al., column 3, lines 61-62). A further object is to provide a

floor covering including a polymeric sheet and lithographic ink or electrographic toner which will have sufficient adhesion to permit use as a floor covering (Davey et al., column 2, lines 43-47). Appellants respectfully submit that the field including the art of adhering incompatible inks to polymeric films, particularly films suitable as floor coverings is not reasonably pertinent to Appellants' field of endeavor, that being methods and articles including an ink or an image on an elastomeric bandage. Floorings are relatively rigid and permanent, requiring the ability to withstand relatively heavy bodies walking and sliding over the surfaces. Bandages, however, are relatively flexible and elastomeric, requiring any image thereon to be able to withstand forming to and flexing with an animate body.

Additionally, there is no similarity in structure or function between Appellants' elastomeric bandages and the polymeric sheets of Davey et al. that are suitable for use as floor coverings. Furthermore, there would be no reason for one of skill in the art of printing inks and images on elastomeric bandages to look to the field of polymeric sheets suitable as floor coverings to address the problems solved by Appellants' invention.

The Examiner pointed out in the Final Office Action (mailed May 24, 2002, Appendix IV) at page 3 to page 4, paragraph 5, that a bandage does not get nearly the stresses and strains as flooring. Appellants submit that it is not necessarily the degree of the stresses and strains to which a bandage is subjected to that is of concern in the art, but the type of stresses and strains. A bandage is required to form to and flex with bodily movements once it is affixed to a

body. Such stresses and strains are not required of sheeting on flooring, which remains essentially in the same position once it is fixed to a surface. There would be, therefore, no reason for one skilled in the art of elastomeric bandages to look to the art of floorings to provide solutions for the stresses and strains inherent to the art of bandages.

Miyamoto et al. disclose polyurethane resins as a binder with a pigment for use on plastic films (Miyamoto et al., page 6, lines 32-33, 35) or for use as a laminating adhesive (Miyamoto et al., page 7, line 9). The resins relate to use with flexible packaging, particularly in the food packaging industry (Miyamoto et al., page 2, lines 6-9), useful for boiling and retorting in hot water to cook or sterilize package contents (Miyamoto et al., page 2, lines 17-18). While the polymer film on which the resins are printed or extruded may be flexible, they are not necessarily elastomeric.

Appellants submit that Davey et al. and Miyamoto et al., drawn to nonanalogous art, may not be used as prior art in combination with Hassell in making an obviousness rejection.

2. There is no motivation for one skilled in the art to combine the teachings of Davey et al. with the teachings of Hassell and Miyamoto et al.

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary

skill in the art." In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391, 393 (CCPA 1965). A single statement in the prior art document should not be taken out of context and relied upon with the benefit of hindsight to show obviousness; rather, a document should be considered as a whole. Bausch & Lomb, Inc. v. Barnes-Hind/Hycrocurve, Inc., 796 F.2d 443, 230 U.S.P.Q. 416, 419-420 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), on remand, 10 U.S.P.Q. 2d 1929 (N.D. Calif. 1989).

Appellants submit that Davey et al. and Miyamoto et al. are excluded from use in a prior art rejection as nonanalogous art. Furthermore, neither document provides any motivation whatsoever to one of skill in the art to combine the teachings of Davey et al. with the teachings of Hassell, providing an adhesive bandage having indicia printed with "suitable inks" thereon (Hassell, column 3, line 25) and the teachings of Miyamoto et al. to supply the methods and elastomeric bandages of Appellants' invention. There is no incentive whatsoever for one of skill in the art to look to either the surface products for floors, walls, and furniture of Davey et al. or the boiling and retorting food packaging of Miyamoto et al. for a solution to the problems encountered when inks and images are applied to elastomeric bandages. Furthermore, one of skill in the art would not reasonably expect that the methods and articles of either the fields of surface products for floors, walls and furniture and/or the field of food packaging could be successfully applied to the art of elastomeric bandages.

3. It is impermissible to use hindsight as an obviousness test.

Appellants respectfully submit that the use of Davey et al. in view of Hassell and Miyamoto et al. in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order to establish a *prima facie* case of obviousness, the document must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, . . . was a legally improper way to simplify the difficult determination of obviousness."). One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Appellants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the combination of its teachings nor suggests the reasonable likelihood that such a combination would result in the present invention.

Appellants respectfully submit that the teachings of Davey et al. in view of Hassell and Miyamoto et al. are woefully inadequate to teach or suggest an elastomeric bandage comprising a printed image, and to teach or suggest methods for printing an image on an

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elastomeric bandage, methods for improving durability of an image on an elastomeric bandage, and methods for limiting abrasion of an ink on an elastomeric bandage. Impermissible hindsight was used to sift through the prior art in order to reconstruct the claimed invention using Appellants' specification as a template for selecting a particular teaching.

Furthermore, there is simply no teaching, suggestion, or incentive in Davey et al., Hassell, or Miyamoto et al. to provide a motivation to combine their teachings to provide the elastomeric bandage and methods of Appellant's invention, specifically in view of the fact that both Davey et al. and Miyamoto et al. are drawn to nonanalogous art.

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B. Summary

For the many foregoing reasons, it is respectfully submitted that *prima facie* case of obviousness has not been established. It is earnestly requested that the Board reverse the Examiner's rejection, and that all of the claims be allowed.

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